

## **REMARKS**

### **I. Introduction**

This paper is responsive to the non-final Office Action mailed July 22, 2011. The Applicants and undersigned thank Examiner Dowling for his consideration of the present application.

Claims 10, 13, 15, 19, 21 and 23-25 are amended. Claim 12 is canceled. Claims 26 and 27 are added. Examples of support for the amendments and new claims can be found in the originally filed specification at paragraphs [0044] and [0047]-[0049]. Other portions of the specification, and the Figures, may also provide support. Claims 1-11 and 13-27 are pending after entry of the claim amendments.

Claims 1-9 stand allowed. Claims 11, 18 and 20 stand objected to as depending from a rejected base claim, but are otherwise allowable. Claims 10, 13-17, 19 and 21-25 stand rejected.

The Applicants submit that all of the pending claims are patentable, as explained below. Accordingly, the Applicants respectfully request that the U.S. Patent & Trademark Office (the "Office") issue a Notice of Allowance.

### **II. Claims 21-22 are Patentable**

The Office Action rejected claims 21-22 under 35 U.S.C. § 103(a) as being obvious over a combination of U.S. Patent No. 4,114,996 to Shaw ("Shaw") in view of WO 98/44388 to Digiulio, *et al.* ("Digiulio"). The Applicants respectfully traverse these rejections for the following reasons.

First, claim 21 has been amended, solely in an effort to expedite prosecution, to set forth explicitly, “automatically engaging at least one perforation of the film by at least one registration pin extending into the film transport path from a retracted position with respect to the film transport path.” Even assuming for arguments sake only that a reason existed to combine Shaw and Digiulio, the combination fails to teach or suggest claims 21-22 because the combination fails to teach or suggest at least this feature. The Applicants submit that claims 21 and 22 are patentable over Shaw and Digiulio for at least this reason and request withdrawal of the rejection and allowance of claims 21 and 22.

Second, claim 21 requires “threading film through a film transport path by the input drive assembly.” The Office construed “threading” using “thread” in “Webster’s Ninth New Collegiate dictionary” as “to pass into or through something” and alleged that Shaw disclosed this claimed feature as construed by the Office.<sup>1</sup> The Applicants do not necessarily adopt the Office’s construction of “threading” in claim 21 and submit that even Webster’s Ninth New Collegiate dictionary, if applicable here,<sup>2</sup> defines the verb “thread” in multiple ways as follows:

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<sup>1</sup> Non-final Office Action, pp. 3-4.

<sup>2</sup> Indeed, the Office failed to identify the year for the dictionary that it referenced such that the Office and Applicants are unable determine whether such dictionary defines terms consistently as those terms were defined as of the invention date for the present claims. Applicants’ copy of Webster’s Ninth New Collegiate dictionary is dated 1989, approximately fifteen years earlier than the priority date for the present application. Nothing in this paper should be interpreted as Applicants agreeing that Webster’s Ninth New Collegiate dictionary is applicable to the present application.

1       a: to pass a thread through the eye of (a needle)  
         b: to arrange a thread, yarn, or lead-in piece in working position  
for use in (a machine)

2       a: (1): to pass something through in the manner of a thread <~ a  
pipe with wire> (2): to pass (as a tape, line, or film) into or through  
something <~ed a fresh film into the camera>

....

Among these, the Office selected definition 2(a)(2), apparently without regard to the specification, which is impermissible.<sup>3</sup>

The Applicants submit that when properly construed it is clear the cited references do not disclose or suggest “threading film through a film transport path by the input drive assembly.” Shaw instead discloses, for example in column 2, line 20 to column 3, line 14, how film advances through a film transport after the film has already been set-up in the film transport, not threading film as claimed. Withdrawal of the rejection and allowance of claims 21 and 22 for at least this additional reason is requested.

Third, claims 21 and 22 stand rejected by the Office because “it has been held that to make something previous[ly] done manual[ ] automatic is not a patentable distinction.”<sup>4</sup> The Applicants respectfully submit that such basis for rejecting the claims is improper because (i) the Office failed to identify any applicable case supporting this proposition and (ii) the Office failed to engage in a

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<sup>3</sup> *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316 (Fed. Cir. 2005) (*en banc*) (“The PTO determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction ‘in light of the specification as it would be interpreted by one of ordinary skill in the art.’”) quoting *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004).

<sup>4</sup> *Id.* at p. 4.

comparison of the facts of any case supporting the proposition with respect to claim 21. Specifically, the Office did not identify any case supporting the proposition that all inventions that convert previously manual steps to automatic steps are not patentably distinguishable such that the proposition, and the rejection of the claims, is unsupported by substantial evidence. Moreover, the Office relied on a rationale from case law without establishing that the facts from such case law are similar to those at hand.<sup>5</sup> Instead, the Office merely included a conclusion. Withdrawal of the rejection and allowance of claims 21-22 for at least this additional reason is requested.

### **III. Claims 10, 13-17 and 23-25 are Patentable**

The Office Action rejected claims 10, 13-17 and 23-25 under 35 U.S.C. § 103(a) as being obvious over a combination of Shaw in view of Digiulio and U.S. Patent No. 5,946,076 to Goodhill, *et al.* The Applicants respectfully traverse these rejections for the following reasons.

First, each of claims 10 and 23 are amended to require “the input drive assembly comprises ... (ii) a variable speed sprocket, and (iii) a constant speed sprocket” and “a loop gap between the variable speed sprocket and the constant speed sprocket that is sized based on a difference in film speed between the variable speed sprocket and the constant speed sprocket.” The combination (assuming a reason existed to make the combination, which is not conceded) does not disclose or suggest these features. Goodhill, for example and for the

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<sup>5</sup> See M.P.E.P. § 2144.04.

combination, does not include a loop gap between a variable speed sprocket and a constant speed sprocket, wherein the loop gap is sized based on a difference in film speed between the variable speed sprocket and the constant speed sprocket (even assuming that Goodhill discloses using a variable speed sprocket with a constant speed sprocket, which is not conceded). Nor is there a need to include these features in Shaw, Digiulio, and/or Goodhill. Withdrawal of the rejection and allowance of claims 10, 13-17 and 23-25 is requested for at least this reason.

Second, the Office Action failed to articulate an apparent reason supported by evidence as to why one of ordinary skill would have combined teachings from Shaw, Digiulio<sup>6</sup> and Goodhill together to arrive at the inventions in claims 10, 13-17 and 23-25. Thus, the Office failed to establish *prima facie* obviousness.<sup>7</sup> Instead, the Office stated as follows:

It would have been obvious to one of ordinary skill in the art to provide an electronic controller and variable speed motors, as taught by Goodhill, to control the film sprockets and rotor speed in order to allow for control of the film feeding speed for forming the film loops and controlling the transport speed of the film, as desired. It further would have been obvious to allow for a change in timing operation, i.e. how fast each frame is positioned or stays in the aperture because it is well known to operate devices at different speeds on different occasions and situations, such as for film formats and desired projection speed.<sup>8</sup>

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<sup>6</sup> The Office does not appear to rely on Digiulio for any feature in claims 10, 13-17 and 23-25. The Office stated on page 5 that Digiulio “teaches the known use of supply and take-up reel in a film transport system,” but a “supply and take-up reel” is not recited in any of these claims. Should the Office continue to reject these claims in view of Digiulio, the Applicants respectfully request an explanation as to which claimed features for which the Office relies on Digiulio.

<sup>7</sup> *KSR Int’l Co. v. Teleflex, Inc.* 550 U.S. 398, 418 (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (requiring articulation of an apparent reason to combine elements to establish obviousness).

<sup>8</sup> Office Action, pp. 6-7.

The Office offered nothing to establish that this is true. Indeed, the Office has solely shown that each claimed element was, independently known (and this is at best since Applicants do not concede that each claimed element was independently known). “[A] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.”<sup>9</sup> All the Office established here is that all elements were independently known (according to the Office and which is not conceded). The Office failed to establish that there was an apparent reason, supported by evidence, to combine them. Withdrawal of the rejection and allowance of claims 10, 13-17 and 23-25 is requested for at least this reason.

#### **IV. Claim 19 is Patentable**

The Office Action rejected claim 19 under 35 U.S.C. § 103(a) as being obvious over a combination of Shaw in view of Digiuli, Goodhill and U.S. Patent No. 3,600,073 to Shaw – (“Shaw 073”). The Applicants respectfully traverse these rejections for the following reasons. Claim 19 depends from and further limits claim 10. Reasons for allowing claim 10 are provided above. The Applicants submit that claim 19 is patentable for at least those same reasons. Withdrawal of the rejection and allowance of claim 19 is requested.

Moreover, claim 19 is patentable because the Office failed to establish *prima facie* obviousness by failing to articulate an apparent reasons supported by evidence as to why one would have combined reference teachings together. In rejecting

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<sup>9</sup> *KSR Int’l Co. v. Teleflex, Inc.* 550 U.S. at 418 (2007) (emphasis added).

claim 19, the Office stated that “[i]t would have been obvious to one of ordinary skill in the art to modify the above combination by the addition of an air system, as taught by [Shaw 073] to facilitate eliminating longitudinal bending of the film.”<sup>10</sup> Again, all that is shown by the Office is that each claimed element was independently known (according to the Office and which is not conceded), which under *KSR* is insufficient to establish obviousness. Put more plainly, the Office explained that it would have been obvious to practice the teachings (as interpreted by the Office) of Shaw 073, which would be true for any claimed element that is independently known in the art. What the Office has not shown, and is required to show to establish obviousness, is **why** one would have practiced those teachings **with the teachings** from the other references. Merely finding that a claimed feature was independently known is not enough under *KSR*. Withdrawal of the rejection and allowance of claim 19 for this additional reason is requested.

#### **V. New Claims 26 and 27**

New claim 26 is added that depends from claim 23. New claim 27 is added that depends from claim 10. Reasons for allowing each of claims 10 and 23 are provided above. The Applicants submit that claims 26 and 27 are also patentable for at least the same reasons. Allowance of claims 26 and 27 is requested.

#### **VI. Conclusion**

The above amendments and remarks completely respond to the Office Action and place the application in condition for allowance, which is respectfully requested.

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<sup>10</sup> Office Action, p. 7.

No fee is believed to be due for this submission. If any additional fees are due for this submission, the fees may be charged to Deposit Account number 20-1430. If there are any matters that can be addressed by telephone, the Examiner is urged to contact the undersigned attorney at 404-745-2520.

The Office is also hereby authorized to communicate with the undersigned by electronic mail concerning any subject related to this application.

Respectfully submitted,

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